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09/769,514	01/26/2001	Oscar A. Mondragon	2585-0113P	6115
22862	7590	05/04/2006	EXAMINER	
GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025			JANVIER, JEAN D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/769,514

Applicant(s)

MONDRAGON, OSCAR A.

Examiner

Jean Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/14/16 has been entered and a Non-Final Action follows.

**Detailed Action**

***Specification***

On page 4, line 14, “the user of the available combinations of companies **who** are interested in sponsoring...” should apparently be -- the user of the available combinations of companies **that** are interested in sponsoring...--

On page 8 (abstract), lines 2 and 3, in the “The user may access the web page of a service provider, **where said user is and sponsors.**”, the underlined portion is incomplete and unclear.

Throughout the specification, “internet” should apparently be - -Internet--.

**Claim Status**

Claims 1-15 are still pending in the Application.

*Claim Objections*

Claims 1 and 9 are objected to because of the following informalities-

In claim 1, "...providing said user a menu..." should apparently be --...providing said user **with** a menu...--.

Regarding claim 9, "a user choosing a combination..." should apparently be - - choosing by a user a combination...--

Throughout the claimed invention, "internet" should apparently be - -Internet--.

Appropriate corrections are requested.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 (including its dependent claims) are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for **"the application selected by the user takes on the look and feel, also known as skin (such a logo or a trademark of the**

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**sponsor)” of the selected sponsor of the service...”, see paragraph [0013], however, the specification does not reasonably provide enablement for “wherein said skin comprises at least one of a background image, a border, a button appearance, a button location and shape of said Internet application” as amended.**

In general, **“the look and feel, also known as skin” as recited in claims 1 and 15 are interpreted as - a logo or a trademark of the sponsor--.**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 15 is rejected under 35 U.S.C. 102(e) as being anticipated by Krishan et al. (hereinafter Krishan), US Patent 6, 442, 529 B1.

As per claim 15, Krishan discloses a system for delivering targeted advertisements or messages to an identified user in a manner that does not interfere with the user's browsing session conducted over the Internet. The system comprising:

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A plurality of user-terminals or computers 50 used by users 22 (fig. 1A and fig. 4);

At least one Web file server or Ad Server 54 of fig. 4 and/or Content Server 56 of fig. 4 containing a plurality of advertisement files (col. 12: 53-65);

At least one Internet service server or a system used by ISP 24 offering an Internet service or subsidized or free Internet access to users 22 who agree to read advertisements from advertisers 26 while their computers 50 of fig. 4 or terminals are in an idle mode or bandwidth use is low (A sponsor or ISP provides subsidized or free Internet access (free service) to users who agree to read advertisements-see abstract; col. 3: 37 to col. 4: 45);

At least one Internet service plug-in or software provided along with a modem (mini-portal) by Portal Provider 20 in agreement with ISP 24 to users 22 so that the users can connect to the Internet via ISP 24 system and wherein the modem and software permit advertisements or messages to be displayed on the users' computers screens while dialing-up into the ISP system or server and while the Internet connection is idle (during low or no browsing activity) and wherein the software may function as a device driver for the modem, a proxy server, as part of the operating system, an application program or a browser plug-in and wherein this software or browser plug-in is coupled to the rest of the system (ISP 24 server or advertisement server 54) (col. 5: 52-66; col. 16: 15-23);

A control center or Portal Provider 20 using statistical server 55 of fig. 4 receives and analyzes user information or interaction or responses to the advertisements or messages reported or collected by said advertisement server 54 of fig. 4, which gathers the statistical data from the mini-portal 51 (software) running on the users' computers 50 and sends controlling commands to said advertisement server 54 or ISP 24 to control each of said user

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terminals 50 by displaying more targeted advertisements to the users 22 based on the users 22 interaction with advertisements previously displayed (col. 4: 28-36; col. 7: 17-32; col. 7: 59-64; col. 13: 8-21; col. 16: 3-7).

See abstract; col. 3: 25 to col. 4: 46; figs. 1A, 1B, 5, 6B, 7 and 8.

**Claim 15 is rejected under 35 U.S.C. 102(e) as being anticipated by Toader, US Patent 5,774,869.**

As per claim 15, Toader discloses a system for providing a sponsor's free Internet access time (free service) to a user for the right to display product information or advertising messages to the user. Indeed, when the user logs into the system, he is given a "mandatory guide tour" of the sponsor's Internet Home page and domain (which provides a look and a feel (skin) of the sponsor providing the free service or free Internet access) where the user is exposed to the advertising messages or product information before the user receives the free Internet access (free service) or before the user is allowed to browse the Net for free for a certain period of time (see abstract; col. 2: 29 to col. 5: 53).

**Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Alles, US Patent 6, 425, 010.**

As per claims 1-14, Alles discloses a system for providing an Internet Access Provider or ISP (IAP) with a simple mechanism or means to steer users to given **Internet services, such as**

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**(free) Web pages (applications), of sponsors.** The mechanism allows a sponsor to grant a dial-in user unlimited **(free) access to the Internet after the user has first accessed its Internet services.** The system is thus important for any IAP or ISP that wants to receive income from sponsors by steering or directing **Internet users to the sponsors' services.** In the ultimate case, an IAP could receive all its income from sponsors and thus be able to offer the **Internet access for free to the user (revenues received from the advertisers or sponsors are used to provide free Internet access to the user(s)).** Here, and in general, a user is steered to the Internet services of a sponsor based on the sponsor's specific called telephone number or a sponsor specific login name. It is herein understood that the IAP steers users to given **Internet services, such as a plurality or a menu of (free) Web pages (applications), of sponsors, wherein a list (menu) of sponsors, associated with the Internet services, or at least their phone numbers or login names is also provided or available and the user selects one of the provided phone numbers to indicate that he desires to receive (free) Internet services (free web pages) from a specific sponsor** (At times, Applications and services may be used interchangeably as paragraph [0009] of the specification seems to suggest). See abstract; col. 1: 29-38; col. 1: 45-46.

A party that provides services on the Internet makes a sponsoring agreement with an IAP or ISP. The sponsor and the IAP agree on how users identify themselves as customers of the sponsor when accessing the Internet and which services, **from a list,** the users are allowed to access before they are granted unlimited Internet access (col. 1: 66 to col. 2: 4).

The services that the customers of the selected sponsor are allowed to access before they are granted unlimited Internet access (free service) can be identified by IP addresses of the servers where the services reside. If needed, the IP addresses can be further augmented by TCP



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or UDP port numbers that identify individual applications within the servers the users can access (col. 2: 13-18).

Once the method of sponsor identification and the list (menu) of services has been agreed on, the information is stored in a central database that can be queried by the network devices of the IAP. Alternatively, the information is distributed to all relevant network devices of the IAP (col. 2: 20-23).

**The sponsor advertises to the public or users its willingness to sponsor (subsidized or free) Internet access in return for reading the sponsor's advertisements. The advertisements include the Internet access telephone number(s) and, if needed, a login name that the users need to use in order to exploit the sponsor's offer (col. 2: 25-29).**

The access list (menu) contains the IP address of the user's terminal device and the IP address (es) of the server(s) that the user is allowed to access by the sponsor before unlimited free Internet access is granted to the user. If the set of applications (free services such as web pages) is restricted, the allowed or denied services can be identified by their TCP or UDP port numbers. The access list (menu) forces the user to first access only the services of the sponsor before the user can access anything else on the Internet **in an unlimited manner**. If the sponsor's services are Web based, then this gives the user an incentive to configure **a home page of the sponsor (look and feel or skin of the selected sponsor) as the user's starting Web page (opening web page)**. At this point the user is thus able to only access the Internet services of the **selected** sponsor. The sponsor can exploit the situation by various ways. For example, the sponsor can make the user register and/or login on the sponsor's home page before granting the

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user unlimited access to the Internet. In another example, the sponsor may simply ask the user to visit some of the sponsor's Web pages as the **precondition** of unlimited access to the Internet (displaying a menu of free services along with the corresponding sponsors' names and receiving a selection of a sponsor from a user and allowing the user to choose one service, such a web page (application), from the selected sponsor's displayed services before the user is granted unlimited access to the Internet- Col. 2: 65 to col. 3: 19; col. 3: 53-57; see claims 2, 3 and 7 of the present reference).

It is further understood that an ISP, providing free or paid Internet access to a user, enables the user during a registration or sign-up process to setup a username and a password, wherein the username becomes part of the user's e-mail address at the ISP and wherein the ISP assigns a certain amount of free disk space to the user to store his incoming e-mail data.

### **Response To Applicant's Arguments**

Applicant's arguments with respect to the claimed invention have been considered, but are moot in view of new grounds of rejection.

### **Conclusion**

Although the following references were not officially used in the Office Action, they were considered as relevant prior art. Applicants are further directed to review these references.

Patent 6, 216, 112B1 to Fuller discloses, among other things, a system for periodically communicating a plurality of parameters, such the application software usage records by the user, by an application software to a remote device or remote server or the computer server,

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wherein this communicating is performed by a local browser plug-in running on the user's PC whenever the user logs into the Internet and wherein this usage information is used to update or refresh the application software or advertisements using a hook originally encoded within the application software and/or to properly compensate developers or authors of the application software (See abstract; col. 2: 39-43; col. 2: 50-67; col. 3: 46-56; col. 5: 1-4).

USP 6,141,010 to Hoyle discloses a method and apparatus for providing an automatically upgradeable software application that includes targeted advertising based upon demographics and user interaction with the computer. The software application is a graphical user interface that includes a display region used for banner advertising that is downloaded from time to time over a network such as the Internet. The software application is accessible from a server via the Internet and demographic information on the user is acquired by the server and used for determining what banner advertising will be sent to the user. The software application further targets the advertisements in response to normal user interaction, or use, of the computer. Associated with each banner advertisement is a set of data that is used by the software application in determining when a particular banner is to be displayed. This includes the specification of certain programs that the user may have so that, when the user runs the program (such as a spreadsheet program), an advertisement will be displayed that is relevant to that program (such as an advertisement for a stock brokerage). This provides two-tiered, real-time targeting of advertising--both demographically and reactively. The software application includes programming that accesses the server on occasion to determine if one or more components of the application need upgrading to a newer version. If so, the components are downloaded and installed without requiring any input or action by the user.

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US Patent 5,959,621A to Nawaz

US Patent 6,148, 332A to Brewer et al.

US Patent 6,237,039B1 to Perlman

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113. Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

**Please provide support, that is page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.**

JDJ

04/29/06

**JEAN D. JANVIER**  
**PRIMARY EXAMINER**

